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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,511	06/25/2003	Ryoichi Takasu	105-86 PCT/US	3638
23869	7590	09/23/2004	EXAMINER	
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			CHU, JOHN S Y	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/603,511

Applicant(s)

TAKASU ET AL.

Examiner

John S. Chu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 1971.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-10 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/25/03, 2/17/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This Office action is in response to the application filed June 25, 2004 and the election received July 1, 2004.

1. Claim 24 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 1, 2004.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 6-10, and 17 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by HADA et al (6444,397 B2).

The claimed invention is drawn to the following:

1. An alkali-developable negative resist composition comprising a compound (A) which generates an acid upon exposure to radiation, and a resin component (B) which is made insoluble in alkali under the action of an acid, wherein the component (B) is a resin component containing:

- (b1) a unit which becomes insoluble in an alkali solution as a result of the formation of a lactone under the action of an acid generated from the component (A), and

- (b2) a unit having an alcoholic hydroxyl group.

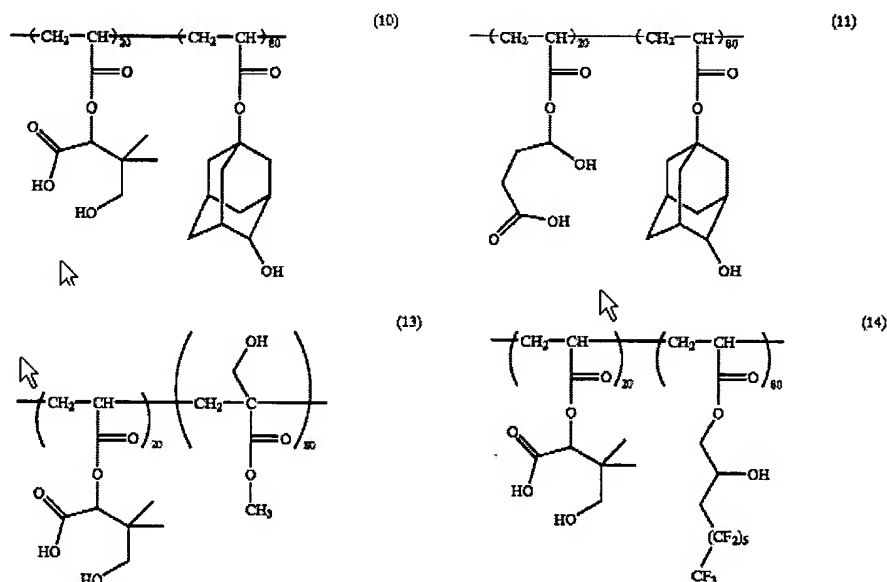
HADA et al anticipates the claimed invention by disclosing a negative working photoresist composition comprising a compound capable of releasing an acid by irradiation with actinic rays, and a resinous compound capable of being insolubilized in an aqueous alkaline solution by interacting with an acid. The resin has two functional groups capable of reacting with each other by dehydration or dealcoholation to form an ester linkage in the presence of an acid whereby the resinous compound is insolubilized in an aqueous alkaline solution.

Applicants are directed to Preparation 2 in column 8, lines 45-63 wherein a copolymer of a  $\alpha$ -(hydroxymethyl) acrylic acid and ethyl  $\alpha$ -(hydroxymethyl) acrylate is formed and is referred to as Polymer 2. This copolymer used in Example 2 along with triphenylsulfonium trifluoromethanesulfonate acid generator in a propyleneglycol monomethyl ether solvent meet and anticipate the claimed negative resist composition as recited in claim 1.

Claims 1, 11-23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by YOKOYAMA et al (2003/0134232 A1).

The claimed invention has been recited above and is included by reference.

YOKOYAMA et al discloses a negative working photoresist composition comprising a resin binder and a photoacid generating compound. Said resin binder can be found on page 7, subparagraph [0085], defined as formula (10), page 8 subparagraph [0097] (formula 11), page 9, subparagraph [0105] (formula 13) and subparagraph [0109] (formula 14). The respective resin binders have the following structures, which anticipate the claimed invention as recited below:



4. Claims 3-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the prior art references disclose the claimed limitations as recited such as said polycyclic non-aromatic hydrocarbon group bonded to a δ-hydroxyacid group.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (571) 272-1329. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

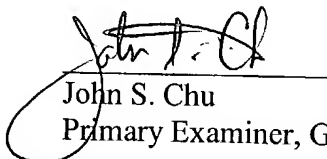
The fax phone number for the USPTO is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John S. Chu  
Primary Examiner, Group 1700

J.Chu

September 19, 2004